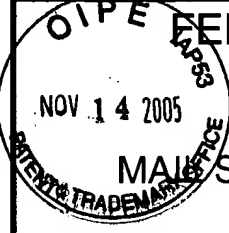



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|---|---|--|----------------------------|---|------------------------------|------------------------------|-----------------------|
|  | | <i>Complete If Known</i> | | | | | |
| | | Application No. | 09/772,601 | | | | |
| | | Filing Date | January 30, 2001 | | | | |
| | | First Named Inventor | Thomas W. POPLAWSKI et al. | | | | |
| | | Examiner Name | Daniel S. FELTEN | | | | |
| <input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27 | | Art Unit | 3624 | | | | |
| Total Amount Of Payment (\$) 500.00 | | Attorney Docket No. | 72167.000247 | | | | |
| METHOD OF PAYMENT (check all that apply) | | | | | | | |
| <input checked="" type="checkbox"/> Check <input type="checkbox"/> Credit Card <input type="checkbox"/> Money Order <input type="checkbox"/> None <input type="checkbox"/> Other (identify): _____ | | | | | | | |
| <input checked="" type="checkbox"/> Deposit Account Deposit Account Number 50-0206 Deposit Account Name: Hunton & Williams LLP | | | | | | | |
| For the above-identified deposit account, the Director is hereby authorized to: (check all that apply) | | | | | | | |
| <input checked="" type="checkbox"/> Charge fee(s) indicated below. <input type="checkbox"/> Charge fee(s) indicated below, except for the filing fee | | | | | | | |
| <input checked="" type="checkbox"/> Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 <input checked="" type="checkbox"/> Credit any overpayments. | | | | | | | |
| FEE CALCULATION | | | | | | | |
| 1. BASIC FILING, SEARCH AND EXAMINATION FEES | | | | | | | |
| | FILING FEES | | SEARCH FEES | EXAMINATION FEES | | | |
| <u>Application Type</u> | <u>Fee(\$)</u> | <u>Small Entity Fee (\$)</u> | <u>Fee(\$)</u> | <u>Small Entity Fee (\$)</u> | <u>Fee(\$)</u> | <u>Small Entity Fee (\$)</u> | <u>Fees Paid (\$)</u> |
| Utility | 300.00 | 150.00 | 500.00 | 250.00 | 200.00 | 100.00 | |
| Design | 200.00 | 100.00 | 100.00 | 50.00 | 130.00 | 65.00 | |
| Plant | 200.00 | 100.00 | 300.00 | 150.00 | 160.00 | 80.00 | |
| Reissue | 300.00 | 150.00 | 500.00 | 250.00 | 600.00 | 300.00 | |
| Provisional | 200.00 | 100.00 | 0.00 | 0.00 | 0.00 | 0.00 | |
| 2. EXCESS CLAIMS FEES | | | | | | | |
| <u>For</u> | <u>Number Present</u> | <u>Highest Number Paid For</u> | <u>Extra</u> | <u>Fees (\$)</u> | <u>Small Entity Fee (\$)</u> | <u>Fees Paid (\$)</u> | |
| Total Claims | | 20 | 0 x | 50.00 | 25.00 | | |
| Independent Claims | | 3 | 0 x | 200.00 | 100.00 | | |
| Multiple Dependent Claim | | | | 360.00 | 180.00 | | |
| Total Excess Claims Fees | | | | | | | |
| 3. APPLICATION SIZE FEE (if the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s). | | | | | | | |
| <u>Total Sheets</u> | <u>Extra Sheets</u> | <u>No. of Each Additional 50 or Fraction Thereof</u> | <u>Fees (\$)</u> | <u>Small Entity Fee (\$)</u> | <u>Fees Paid (\$)</u> | | |
| _____ - 100 = | _____ / 50 = | _____ (round up to a whole number) x | 250.00 | 125.00 | | | |
| 4. OTHER FEE(S) | | | | | | | |
| <input type="checkbox"/> Non-English Specification (no small entity discount) | | | | <input type="checkbox"/> Utility Issue Fee (or Reissue) (including Publication Fee, if necessary) | | | |
| <input type="checkbox"/> Surcharge - late filing fee or oath | | | | <input type="checkbox"/> Design Issue Fee | | | |
| <input type="checkbox"/> Surcharge - late provisional filing fee or cover sheet | | | | <input type="checkbox"/> Plant Issue Fee | | | |
| <input type="checkbox"/> _____ Month Extension of Time | | | | <input type="checkbox"/> Petition to Commissioner | | | |
| <input type="checkbox"/> Submission of Information Disclosure Statement | | | | <input type="checkbox"/> Petition to Revive (Unavoidable) | | | |
| <input type="checkbox"/> Notice of Appeal | | | | <input type="checkbox"/> Petition to Revive (Unintentional) | | | |
| <input type="checkbox"/> Request for Oral Hearing | | | | <input type="checkbox"/> Petitions Related to Provisional Applications | | | |
| <input checked="" type="checkbox"/> APPEAL BRIEF 500.00 | | | | <input type="checkbox"/> Recording Each Patent Assignment Per Property | | | |
| <input type="checkbox"/> Filing Submission After Final Rejection | | | | <input type="checkbox"/> Other (specify) _____ | | | |
| SUBMITTED BY | | | | | | | |
| Signature |  | | | Registration No. | L0214 | Tele | 202.955.1500 |
| Typed or Printed Name | Ce Li | | | Date | November 14, 2005 | | |



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of:

Thomas W. POPLAWSKI *et al.*

Application No.: 09/772,601

Filed: January 30, 2001

For: ELECTRONIC BILL
PRESENTMENT AND PAYMENT
SYSTEM AND METHOD

Group Art Unit: 3624

Confirmation No.: 1711

Examiner: Daniel S. FELTEN

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

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TABLE OF CONTENTS

| | <u>Page</u> |
|---|-------------|
| I. Real Party In Interest | 4 |
| II. Related Appeals and Interferences..... | 4 |
| III. Status of Claims | 4 |
| IV. Status of Amendments | 4 |
| V. Summary of Claimed Subject Matter | 5 |
| VI. Grounds of Rejection to be Reviewed on Appeal..... | 7 |
| VII. Argument | 8 |
| A. Summary of Argument | 8 |
| B. Independent Claim 1 is Patentable over the Cited References | 8 |
| 1. The Cited References Do Not Teach or Suggest “at least one portion of the electronic summary being formatted in the form of a remittance slip” or “printable to serve as a remittance slip in a traditional method of payment” | 9 |
| 2. The Cited References Teach Away From “allowing the at least one payer to choose between paying the at least one bill electronically or mailing the remittance slip with an payment of the at least one bill” | 13 |
| C. Independent Claim 19 is Patentable over the Cited References | 16 |
| D. Independent Claim 24 is Patentable over the Cited References | 16 |
| E. Dependent Claims 2-18, 20-23 and 25-32 Are Each Separately Patentable Over the Cited References | 17 |
| VIII. Claims Appendix | 18 |
| IX. Evidence Appendix..... | 18 |
| X. Related Proceedings Appendix..... | 18 |
| XI. Conclusion | 19 |
| Appendix A..... | 20 |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re Application of: |) | |
| |) | |
| Thomas W. POPLAWSKI <i>et al.</i> |) | Group Art Unit: 3624 |
| |) | |
| Application No.: 09/772,601 |) | Confirmation No.: 1711 |
| |) | |
| Filed: January 30, 2001 |) | Examiner: Daniel S. FELTEN |
| |) | |
| For: ELECTRONIC BILL |) | |
| PRESENTMENT AND PAYMENT |) | |
| SYSTEM AND METHOD |) | |

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

Appellants' Appeal Brief in connection with the above-captioned patent application (hereinafter "the present application") is hereby submitted in triplicate. The requisite fee in accordance with 37 C.F.R. § 41.20(b)(2) is enclosed. It is respectfully submitted that this Appeal Brief is timely filed in support of the Notice of Appeal filed on September 13, 2005. Each item required by 37 C.F.R. § 41.37 is set forth below. Appellants believe that no additional fees are deemed necessary, however if there are any deficiencies, please charge the undersigned's Deposit Account No. 50-0206.

In response to the Office Action dated June 13, 2005, rejecting pending claims 1-32, Appellants respectfully request that the Board of Patent Appeals and Interferences reconsider and withdraw the rejection of record, and allow the pending claims, which are attached hereto as Appendix A.

I. REAL PARTY IN INTEREST

The Appellants, Thomas W. Poplawski and Khoon-Hong Tan, are the Applicants in the above-identified patent application. The Appellants have assigned their entire interest in the above-identified patent application to The Chase Manhattan Bank (now part of JP Morgan Chase & Co.), having a place of business at 270 Park Avenue, New York, New York 10017.

II. RELATED APPEALS AND INTERFERENCES

The Appellants, the Appellants' legal representative, and the Assignee are not aware of any other appeals or interferences which will directly affect, be directly affected by, or have a bearing on the Board's decision in this Appeal.

III. STATUS OF CLAIMS

Claims 1-32 are pending in the above-identified patent application. Claims 1-32 were finally rejected in an Office Action dated June 13, 2005. The final rejection of claims 1-32 is hereby appealed.

Claims 1-3, 6-9, 17-19, 24-26 and 29-32 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,578,015 to Haseltine et al. (hereinafter "Haseltine") in view of U.S. Patent No. 5,699,528 to Hogan (hereinafter "Hogan"). Claims 4, 5, 10-16, 20-23, 27 and 28 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Haseltine in view of Hogan and further in view of U.S. Patent No. 6,292,789 to Schutzer (hereinafter "Schutzer") and U.S. Patent No. 5,465,206 to Hilt et al (hereinafter "Hilt").

IV. STATUS OF AMENDMENTS

The above-identified patent application was filed on January 30, 2001. A first Office Action (Paper No. 4) was issued on April 24, 2003, rejecting claims 1-32. On August 23, 2003,

a Response to Non-final Office Action was filed with no amendment. A Final Office Action (Paper No. 7) was issued on September 8, 2003, maintaining rejection of claims 1-32. On January 8, 2004, a Request for Continued Examination was filed with a Preliminary Amendment. Another Office Action (Paper No. 10) was issued on January 30, 2004, again rejecting claims 1-32 as amended. On July 30, 2004, a Response to Non-final Office Action was filed with no amendment. Yet another Non-final Office Action (Paper No. 11022004) was issued on November 17, 2004 with new grounds to reject claims 1-32. On March 17, 2005, a Response to Non-final Office Action was filed with no amendment. Another Final Office Action (Paper No. 06082005) was issued on June 13, 2005, maintaining rejection of claims 1-32. On September 13, 2005, a Notice of Appeal was filed together with an after-final amendment to claims 1, 19 and 24.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention, as set forth in claim 1, and as described in the specification of the above-identified patent application, is directed to a method for effectuating bill presentment and payment. The method may comprise the step of maintaining a billing database, the billing database containing detailed billing information with respect to at least one bill, the at least one bill reflecting an account of at least one payer with respect to at least one biller. The method may also comprise the step of generating an electronic summary of the at least one bill using the detailed billing information, at least one portion of the electronic summary being formatted in the form of a remittance slip. The method may further comprise the step of generating an electronic notification with respect to the at least one bill, the electronic notification containing the electronic summary and an address through which the billing database may be accessed. The method may additionally comprise the step of transmitting the electronic notification to the at

least one payer, wherein the at least one portion of the electronic summary is printable to serve as a remittance slip in a traditional method of payment of the at least one bill by the at least one payer, thereby allowing the at least one payer to choose between paying the at least one bill electronically or mailing the remittance slip with an payment of the at least one bill.. *See* present application, pp. 2-3 and accompanying figures.

The present invention, as set forth in claim 19, and as described in the specification of the above-identified patent application, is also directed to a method for effectuating electronic bill presentment and payment. The method may comprise the step of registering at least one biller with a service provider. The method may also comprise the step of maintaining a billing database the billing database containing detailed billing information with respect to at least one payer of the at least one biller. The method may further comprise the step of maintaining an electronic site wherein the at least one payer can view the electronic site, the electronic site containing a display of the detailed billing information. The method may additionally comprise the step of authenticating the at least one payer before allowing the at least one payer access to the display of detailed billing information. The method may further comprise the step of generating an e-mail containing summary information regarding a bill owed by the at least one payer to the at least one biller, at least one portion of the summary information being formatted as a remittance slip. And the method may comprise the step of transmitting the e-mail to the payer, wherein the at least one portion of the summary information is printable to serve as the remittance slip in a traditional method of payment of the bill by the at least one payer, thereby allowing the at least one payer to choose between paying the bill electronically or mailing the remittance slip with an payment of the bill. *See* present application, pp. 2-3 and accompanying figures.

The present invention, as set forth in claim 24, and as described in the specification of the above-identified patent application, is further directed to a system for effectuating bill presentment and payment. The system may comprise a billing database, the billing database containing detailed billing information with respect to at least one bill, the at least one bill reflecting an account of at least one payer with respect to at least one biller. The system may also comprise a processor coupled to the billing database, wherein the processor generates an electronic summary of the at least one bill using detailed billing information, at least one portion of the electronic summary being formatted in the form of a remittance slip, and wherein the processor also generates an electronic notification containing the electronic summary and an address through which the billing database may be accessed. The system may further comprise a communication network coupled to the processor, the processor transmitting the electronic notification to the at least payer over the communication network, wherein the at least one portion of the electronic summary is printable to serve as the remittance slip in a traditional method of payment of the at least one bill by the at least one payer, thereby allowing the at least one payer to choose between paying the at least one bill electronically or mailing the remittance slip with an payment of the at least one bill. *See* present application, pp. 6-7 and accompanying figures.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection are: (1) claims 1-3, 6-9, 17-19, 24-26 and 29-32 are unpatentable over Haseltine (U.S. 6,578,015) in view of Hogan (U.S. 5,699,528) under 35 U.S.C. § 103(a); and (2) claims 4, 5, 10-16, 20-23, 27 and 28 are unpatentable over Haseltine in view of Hogan and further in view of Schutzer (U.S. 6,292,789) and Hilt (U.S. 5,465,206).

VII. ARGUMENT

A. Summary of Argument

Appellants respectfully submit that the rejection of claims 1-32 under 35 U.S.C. § 103(a) is improper. Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Patent Office can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of references. Id. Further, as stated in MPEP § 2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Appellants respectfully submit that the Examiner has not met the burden of proof in establishing the obviousness of the appealed claims 1-32.

B. Independent Claim 1 is Patentable over the Cited References

Appellants submit that the cited references, individually or in combination, do not disclose each and every element of claim 1. Before discussing this ground of rejection, however, a brief summary of a preferred embodiment of Appellants' invention is provided in order to highlight some of its advantageous characteristics.

The present invention relates to a system and method for electronic bill presentment and payment (EBPP) that provides flexible options for both billers and payers. Unlike generic EBPP systems, embodiments of the present invention allow a payer some measure of flexibility and control over a payment while offering the benefits of an electronic bill paying system. The payer may receive an electronic notification containing summary information with respect to a pending bill and can either issue a paper check or schedule an electronic payment of the bill using the EBPP system. *See* present application, p. 2, lines 12-22. Such flexibility is provided by

formatting at least a portion of the bill summary in the form of a remittance slip as is found in a traditional paper-based bill. The bill recipient is then able to print out the remittance slip and to include it with a non-electronic form of payment (e.g., by regular mail). *See* present application, p. 3, lines 1-5.

The electronic bill notification sent to the recipient may also include an embedded Uniform Resource Locator (URL) through which the billing database may be accessed. The billing database may be maintained at an Internet website and may be accessed without any special software. *See* present application, p. 3, lines 6-13.

The biller also enjoys some flexibility in implementing the EBPP system in accordance with embodiments of the present invention. The biller may transparently send bill information to a third-party Customer Service Provider (CSP) or Billing Service Provider (BSP), and the CSP or BSP may generate an HTML-formatted copy of the bill for use by the payers. In addition, the biller may choose to either host payers' online access to the billing database on its own site or allow a CSP or BSP to provide the complete hosting required to allow payers to utilize the present invention. *See* present application, p. 3, lines 14-22.

1. The Cited References Do Not Teach or Suggest “at least one portion of the electronic summary being formatted in the form of a remittance slip” or “printable to serve as a remittance slip in a traditional method of payment”

Neither Haseltine nor Hogan teach or suggest “at least one portion of the electronic summary being formatted in the form of a remittance slip” or “printable to serve as a remittance slip in a traditional method of payment” as recited in claim 1.

The Final Office Action concedes, in page 4, that Haseltine fails to disclose that “the electronic summary can be printed out to serve as a remittance slip in a traditional method of payment ...”

However, the Final Office Action points to the following passage in Hogan as allegedly disclosing these claim elements:

“The billing data is transmitted from device 150 to server computer 160, via which the subscribers are able to access and "browse" their bills on WWW, and pay the bills using one or more accounts such as credit, checking, and NOW accounts, home equity lines of credit, and any other accounts from which funds may be drawn. The billing data is stored in such a form that the subscribers are allowed to view full graphics of their bills on PC's, print the bills on printers connected thereto, and download them for storage. Payment transactions are routed from server computer 160 to another network or system such as MasterCard's Banknet, MasterCard Debit Switch system or the automated clearing house (ACH) for credit and/or debit authorization. Clearing and settlement of the transactions with the appropriate payees are then performed in a conventional manner.” Hogan, col. 5, lines 1-15 (emphasis added).

It appears that the Examiner is particularly referring to the underlined sentence. It is further stated in the Final Office Action that “[t]he ability to print text and images from an Internet website that is displayed on a computer screen is notoriously old and well known with the computer networking art.” Therefore, the Final Office Action asserts:

“to modify Haseltine with the ability to print personal billing information from an Internet website, as taught by Hogan, would be considered an obvious expedient ... because an artisan would recognize the fact that users may prefer/require printed copies as backup of their electronic files in the event that the electronic file(s) and/or database becomes corrupted, compromised and/or lost. Thus an artisan of ordinary skill in the art at the time of the invention would have been motivated to modify Haseltine with Hogan's teachings to have an alternative to viewing the bills and so that the users can feel more secure with using an online billing/payment system.” Final Office Action, page 4.

Appellants respectfully submit that the Examiner's reliance on the above-quoted passage from Hogan and his reasoning are flawed.

First, the Final Office Action fails to recognize that, in Hogan, what is printable is a bill, not a remittance slip. In a telephone interview after the Final Office Action, the Examiner asserted that he considered a remittance slip the same as a bill because, except for different

formats, “they were just data.” However, it is well known that a remittance slip differs from a bill summary not just in format but also in substance because the remittance slip serves quite a different function from the bill. A remittance slip typically does not include detailed billing information as found in the bill itself. Instead, a remittance slip typically includes payment instructions for the payer, certain payee information (e.g., payable to whom, mailing address, etc.), currently known payer information and space for making changes thereto (e.g., customer's change of address and phone number), and payment information (e.g., credit or check, actual amount included, allocation of payment amount between principal and interest). An electronic bill summary, which is for a customer's online viewing purpose only, does not and need not provide such information.

Second, the Final Office Action only focuses on the “printable” aspect but ignored the “formatting” aspect of the claimed invention. As recited in claim 1, in order for it to be printable to serve as a remittance slip, at least a portion of the electronic summary is purposely formatted in the form of a remittance slip. However, Hogan does not teach or suggest formatting any portion of an electronic bill summary in the form of a remittance slip. In the description of its system, Hogan makes no reference to a remittance slip at all. The only instance where the word “remittance” (or “remit”) is used is in the Background of the Invention, where paper checks processing is criticized for entailing significant costs to the payees who receive and handle remittances in this manner. *See* Hogan, col. 1, lines 23-25. Since the printing or mailing of a remittance slip is not recommended at all, there is no need for Hogan’s system to format the bill data for remittance purposes.

Third, the motivations as stated in the Final Office Action -- namely, to have an alternative way of viewing the bill and to secure the bill against data loss -- do not in any way

require that any portion of the electronic bill be formatted or made printable as a remittance slip. For purposes of off-line viewing or data backup, it is only necessary to print out an electronic bill in its entirety so that a hard copy of the bill may be viewed or stored off-line. Such purposes do not justify an extra step of formatting a portion of the bill in the form of a remittance slip.

In the telephone interview, the Examiner attempted to support his application of Hogan by offering an example from his personal experience. The Examiner stated that, on one occasion, he misplaced a paper bill, and, therefore, could not use the remittance slip attached to the paper bill to make a payment by mail. Instead of requesting another copy from the biller, he went online to print out an electronic summary of the bill and used it as a substitute for the original remittance slip. With this example, the Examiner concluded that he was using the same, purportedly well-known method as claimed in the present invention.

However, this example does not cure the deficiencies in the obviousness rejection of claim 1. First, it is unclear whether this incident took place before or after appellants' invention. Second, this example only shows that a bill summary is printable and someone might choose to use it incorrectly for remittance purposes. It does not show that the step of formatting part of an electronic bill in the form of a remittance slip was ever known or performed. Printing out a bill summary for remittance purposes does not necessarily include a step of formatting the bill summary in the form of a remittance slip. Third, the fact that individual customers happen to print out a bill summary to replace a lost remittance slip should not render obvious an invention that explicitly formats a portion of the bill summary to provide a true, printable copy of remittance slip. For instance, the fact that some people may use chewing gum to mend a tear in a piece of paper should not prevent an inventor from patenting the format of adhesive tape in a

tape dispenser. Even if used for remittance purposes, a bill summary printout is still different, in both content and format, from a remittance slip.

In view of the foregoing, it is respectfully submitted that the cited references fail to teach or suggest all the elements in claim 1.

2. The Cited References Teach Away From “allowing the at least one payer to choose between paying the at least one bill electronically or mailing the remittance slip with an payment of the at least one bill”

Claim 1 recites, among other things, “allowing the at least one payer to choose between paying the at least one bill electronically or mailing the remittance slip with an payment of the at least one bill.” This claim element reflects a fundamental difference from the cited references in that it provides a customer of an electronic bill pay system the option to choose between the methods of traditional check-and-mail payment versus online electronic payment.

Other EBPP systems, such as Haseltine, Hogan, Schutzer and Hilt, do not provide such an option at all because they are all-electronic, paperless payment systems. Each of the cited references harshly criticizes the traditional paper-based bill payment method and, at the same time, encourages an all-electronic, paperless bill payment approach. Therefore, not only do they fail to provide a motivation for the modifications or combinations asserted in the Final Office Action, the cited references actually teach away from “allowing the at least one payer to choose between paying the at least one bill electronically or mailing the remittance slip with an payment of the at least one bill.”

For example, according to Haseltine:

“As may be appreciated, the paper-based bill generation and payment cycle 100 depicted in FIG. 1 is often both a lengthy and costly process.”
Haseltine, col. 1, lines 55-57.

“Such [electronic bill presentment and payment] methods, devices and systems should also allow customers to view and pay such bills without

the disadvantages associated with conventional electronic payment systems and/or paper bills and checks.” Haseltine, col. 2, lines 26-29.

“It is believed that implementation of the present invention has several advantages over traditional paper-based bill presentation and payment schemes. Indeed, the present invention reduces the processing and administrative costs of the billers, bill publishers and bill consolidators by foregoing paper in favor of an electronic medium. The present invention also reduces the need for paper-based postage and metering, and reduces the time required for delivery of the bill to its intended recipient. Thanks to the automatic bill payment feature of the present invention, late payments of bills may be reduced, resulting in savings for both billers and customers. ” Haseltine, col. 13, lines 41-54.

According to Hogan:

“The most common method of payment of the bills is writing paper checks for the appropriate amounts and mailing such checks to payees. This method is labor intensive and time consuming for a bill-payer, and must be done on multiple occasions each month since the bills do not normally arrive or become due on the same date. In addition, the bill-payer has to absorb the costs of postage in mailing the paper checks to payees. Paper checks processing also entails significant costs to the payees who receive and handle remittances in this manner.” Hogan, col. 1, lines 15-25

“Advantageously, with this invention, a user is able to electronically receive, review and pay the bills through a series of brief on-line sessions each month.” Hogan, col. 2, lines 60-62.

“The present invention is directed to a technique for delivery of bills over a communications network, and payment of the bills through the network using a personal computer (PC).” Hogan, col. 3, lines 47-50.

According to Schutzer:

“Each bill paid by mail costs the consumer a minimum of postage plus checking charges, and each bill sent by mail costs the biller a minimum of postage plus printing charges. It is estimated that around 19 billion bills per year are sent and paid today, not including many non-bill statements. The use of technology for electronic bill presentment and payment can reduce the cost of the billing and payment process for up to 100 million U.S. households and their vendors and service providers.” Schutzer, col. 1, lines 31-39.

According to Hilt:

“Billers, who often are billing small amounts with each transaction, must incur the costs of processing many checks, including the attendant overhead of dealing with remittance processing, such as opening envelopes, data capture of the consumer's account number, MICR (Magnetic Ink Character Recognition) encoding of the check amounts, etc.” Hilt, col. 1, lines 28-33.

“Given the economies of scale, a biller has great incentive to reduce the cost of remittance processing and, more significantly, the biller has an even larger incentive to reduce the cost of "exception items." An exception item is a payment which, for some reason, cannot be processed according to the highly automated procedures put in place by the biller to quickly process remittances. Exception items include checks received without payment coupons, payment coupons received without checks, checks for amounts different than the amounts shown on the corresponding coupons, multiple payment coupons received in an envelope with a single check. The cost to process a typical payment transaction is \$0.09 to \$0.18 per transaction for a high-volume, efficient remittance processing operation, while an exception item transaction might cost as much as \$0.65 to 1.50.” Hilt, col. 1, lines 48-63.

From the above-quoted passages, there can be sensed a strong aversion towards the traditional paper-based bill payment method. All the cited references are completely biller-oriented -- they strive to help a biller to avoid the cost associated with the processing of checks and remittances, but they do not contemplate the possibility that a payer might prefer paying bills in the traditional, paper-based manner. Given this overwhelming preference for electronic payment, there is no ground for believing that the cited references provide any suggestion or motivation for a modification/combination that would give a payer an option to choose the traditional paper-based payment over the electronic payment.

Since the cited references fail to teach or suggest all the elements in claim 1, and they actually teach away from the present invention as recited in claim 1, the Final Office Action has failed to establish a *prima facie* case of obviousness against claim 1.

C. Independent Claim 19 is Patentable over the Cited References

Claim 19 is another independent method claim that recites, among other things, the following limitations: (1) “at least one portion of the summary information being formatted as a remittance slip,” (2) “wherein the at least one portion of the summary information is printable to serve as the remittance slip in a traditional method of payment,” and (3) “thereby allowing the at least one payer to choose between paying the bill electronically or mailing the remittance slip with an payment of the bill.” As discussed above with respect to claim 1, neither Haseltine nor Hogan teach or suggest these three claim elements. In addition, all the cited references teach away from an EBPP method, as recited in claim 19, that provides a payer with a non-electronic payment option. Accordingly, the cited references cannot render claim 19 obvious.

D. Independent Claim 24 is Patentable over the Cited References

Claim 24 is an independent system claim that recites, among other things, the following limitations: (1) “at least one portion of the summary information being formatted as a remittance slip,” (2) “wherein the at least one portion of the summary information is printable to serve as the remittance slip in a traditional method of payment,” and (3) “thereby allowing the at least one payer to choose between paying the at least one bill electronically or mailing the remittance slip with an payment of the at least one bill.” As discussed above with respect to claim 1, neither Haseltine nor Hogan teach or suggest these three claim elements. In addition, all the cited references teach away from an EBPP system, as recited in claim 24, that provides a payer with a non-electronic payment option. Accordingly, the cited references cannot render claim 24 obvious.

E. Dependent Claims 2-18, 20-23 and 25-32 Are Each Separately Patentable Over the Cited References

Claims 2-18, 20-23 and 25-32 all depend ultimately from one of independent claims 1, 19 and 24. As such, each of these dependent claims contain each of the elements recited in the independent claims. For the reasons stated above, the cited references fail to disclose or suggest all the elements recited in claims 1, 19 and 24. Thus, for at least the same reasons, the cited references do not render claims 2-18, 20-23 or 25-32 obvious. Additionally, claims 2-18, 20-23 and 25-32 are each separately patentable over the cited references for the additional features that each of these dependent claims recites.

VIII. CLAIMS APPENDIX

Appendix A contains a listing of currently pending claims.

IX. EVIDENCE APPENDIX

No Evidence Appendix is included herewith.

X. RELATED PROCEEDINGS APPENDIX

No Related Proceedings Appendix is included herewith.

XI. CONCLUSION

For the foregoing reasons, Appellants respectfully submit that the cited references fail to render Appellants' claims 1-32 obvious under 35 U.S.C. § 103(a). Accordingly, Appellants respectfully request reversal of the final rejection of claims 1-32.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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APPENDIX A

1. (Previously Amended) A method for effectuating bill presentment and payment comprising:
 - maintaining a billing database, the billing database containing detailed billing information with respect to at least one bill, the at least one bill reflecting an account of at least one payer with respect to at least one biller;
 - generating an electronic summary of the at least one bill using the detailed billing information, at least one portion of the electronic summary being formatted in the form of a remittance slip;
 - generating an electronic notification with respect to the at least one bill, the electronic notification containing the electronic summary and an address through which the billing database may be accessed; and
 - transmitting the electronic notification to the at least one payer, wherein the at least one portion of the electronic summary is printable to serve as a remittance slip in a traditional method of payment of the at least one bill by the at least one payer, thereby allowing the at least one payer to choose between paying the at least one bill electronically or mailing the remittance slip with an payment of the at least one bill.
2. (Original) The method according to claim 1, further comprising:
 - maintaining an Internet site, wherein the billing database containing the detailed billing information is maintained on the Internet site.
3. (Original) The method according to claim 2, wherein the Internet site is maintained by the at least one biller.
4. (Original) The method according to claim 2, wherein the Internet site is maintained by a Billing Service Provider (BSP) the BSP performing billing services for the at least one biller.
5. (Original) The method according to claim 2, wherein the Internet site is maintained by a Customer Service Provider (CSP) the CSP performing billing services for the at

least one biller.

6. (Original) The method according to claim 2, wherein address through which the billing database may be accessed is a Uniform Resource Locator (URL) address of the Internet site, the method further comprising:

providing the at least one payer with access to the Internet site through the URL; and
authenticating the at least one payer at the Internet site.

7. (Original) The method according to claim 6, further comprising:
allowing the at least one payer with the opportunity to pay the bill electronically on the Internet site.

8. (Original) The method according to claim 6, wherein the electronic notification is an e-mail message.

9. (Original) The method according to claim 6, wherein the step of authenticating the at least one payer requiring the at least one payer to enter a unique username and password.

10. (Original) The method according to claim 1, further comprising:
registering the at least one biller with a billing service provider (BSP), wherein the BSP interfaces with the at least one biller with respect to the presentment of the at least one bill; and
registering the at least one payer with a customer service provider (CSP), wherein the CSP interfaces with the at least one payer with respect to the payment of the at least one bill.

11. (Original) The method according to claim 10, wherein the BSP and CSP are the same entity.

12. (Original) The method according to claim 10, wherein the BSP is a bank.

13. (Original) The method according to claim 10, wherein the CSP is a bank.

14. (Original) The method according to claim 10, wherein there are a plurality of payers that have accounts with the at least one biller, the method further comprising:

transmitting the detailed billing information with respect to the plurality of payers from the at least one biller to the BSP.

15. (Original) The method according to claim 14, wherein the step of transmitting the detailed billing information further comprises:

transmitting the detailed billing information as a bulk file containing all of the detailed billing information for a specified period of time.

16. (Original) The method according to claim 15, wherein the specified period of time is one month.

17. (Original) The method according to claim 1, wherein the electronic summary information contains at least a name of the at least one biller, a statement date, a minimum amount due, a total amount due and a due date.

18. (Original) The method according to claim 1, further comprising:
registering the at least one payer with the at least one biller with respect to receiving the electronic notification of the present invention.

19. (Previously Amended) A method for effectuating electronic bill presentment and payment comprising the steps of:
registering at least one biller with a service provider;
maintaining a billing database the billing database containing detailed billing information with respect to at least one payer of the at least one biller;
maintaining an electronic site wherein the at least one payer can view the electronic site, the electronic site containing a display of the detailed billing information;
authenticating the at least one payer before allowing the at least one payer access to the display of detailed billing information;

generating an e-mail containing summary information regarding a bill owed by the at least one payer to the at least one biller, at least one portion of the summary information being formatted as a remittance slip; and

transmitting the e-mail to the payer, wherein the at least one portion of the summary information is printable to serve as the remittance slip in a traditional method of payment of the bill by the at least one payer, thereby allowing the at least one payer to choose between paying the bill electronically or mailing the remittance slip with an payment of the bill.

20. (Original) The method according to claim 19, wherein the service provider is a business service provider.

21. (Original) The method according to claim 19, wherein the service provider is a customer service provider.

22. (Original) The method according to claim 20, wherein the business service provider is a bank.

23. (Original) The method according to claim 21, wherein the customer service provider is a bank.

24. (Previously Amended) A system for effectuating bill presentment and payment, the system comprising:

a billing database, the billing database containing detailed billing information with respect to at least one bill, the at least one bill reflecting an account of at least one payer with respect to at least one biller;

a processor coupled to the billing database, the processor:

generating an electronic summary of the at least one bill using detailed billing information, at least one portion of the electronic summary being formatted in the form of a remittance slip,

generating an electronic notification containing the electronic summary and containing an address through which the billing database may be accessed; and

a communication network coupled to the processor, the processor transmitting the electronic notification to the at least payer over the communication network, wherein the at least one portion of the electronic summary is printable to serve as the remittance slip in a traditional method of payment of the at least one bill by the at least one payer, thereby allowing the at least one payer to choose between paying the at least one bill electronically or mailing the remittance slip with an payment of the at least one bill.

25. (Original) The system as recited in claim 24 further comprising:
an Internet site, wherein the database containing the detailed billing information is maintained on the Internet site.

26. (Original) The system as recited in claim 25, wherein the Internet site is maintained by the at least one biller.

27. (Original) The system as recited in claim 25, wherein the Internet site is maintained by a billing service provider (BSP) the BSP performing billing services for the at least one biller.

28. (Original) The system as recited in claim 25, wherein the Internet site is maintained by a customer service provider (CSP) the CSP performing billing services for the at least one biller.

29. (Previously Amended) The system according to claim 25, wherein address through which the billing database may be accessed is a Uniform Resource Locator (URL) address of the Internet site, wherein the processor provides the at least one payer with access to the Internet site through the URL, and wherein the processor authenticates the at least one payer at the Internet site.

30. (Original) The system according to claim 29, wherein, the processor allows the at least one payer with the opportunity to pay the bill electronically on the Internet site.

31. (Original) The system according to claim 29, wherein the electronic notification is an e-mail message.

32. (Original) The system according to claim 29, wherein the step of authenticating the at least one payer requiring the at least one payer to enter a unique username and password.